



DEPARTMENT OF HEALTH AND HUMAN SERVICES

National Institutes of Health

Government-Owned Inventions; Availability for Licensing

AGENCY: National Institutes of Health, HHS.

ACTION: Notice.

SUMMARY: The National Heart, Lung, and Blood Institute (NHLBI), National Institutes of Health, Department of Health and Human Services, is contemplating the grant of sublicensable patent licenses to Simon Fraser University (“Simon Fraser”), a non-profit university located in British Columbia, Canada, and Le Centre National de la Recherche Scientifique (“CNRS”), a public scientific and technological establishment located in France, its rights to the inventions and patents listed in the

SUPPLEMENTARY INFORMATION section of this notice

DATES: Only written comments and/or applications for a license which are received by the NHLBI Office of Technology Transfer and Development on or before [INSERT DATE 15 DAYS FROM DATE OF PUBLICATION OF NOTICE IN THE FEDERAL REGISTER] will be considered.

ADDRESSES: Requests for copies of the patent applications, inquiries, and comments relating to the contemplated exclusive patent license should be directed to: Brian W. Bailey, Ph.D., Senior Technology Transfer Manager, NHLBI Office of Technology Transfer and Development, 31 Center Drive Rm 4A29 MSC 2479, Bethesda, MD 20892-2479 (for business mail), Telephone (301) 594-4094; Email: bbailey@mail.nih.gov

SUPPLEMENTARY INFORMATION:

The following and all continuing U.S. and foreign patents/patent applications thereof are the intellectual properties to be licensed under the prospective agreement to Stanford: United States Provisional Patent Application No. 62/489,346 filed April 24, 2017 and

entitled “FLUORIGEN-BINDING RNA APTAMERS” [HHS Reference No. E-152-2018/0-US-01].

The patent rights in these inventions have been assigned to the Government of the United States of America, Simon Fraser, and CNRS. The prospective patent license will be for the purpose of consolidating the patent rights to CNRS, one of the co-owners of said rights, for commercial development, and the purpose of consolidating the patent rights to CNRS and Simon Fraser for marketing. Consolidation of these co-owned rights is intended to expedite development of the invention, consistent with the goals of the Bayh-Dole Act codified as 35 U.S.C. 200-212.

The prospective patent license will be worldwide, exclusive, and may be limited to those fields of use commensurate in scope with the patent rights. It will be sublicensable, and any sublicenses granted by CNRS or Simon Fraser will be subject to the provisions of 37 CFR part 401 and 404.

This invention pertains to certain RNA aptamers with optimized fluorescent properties and fluorophore binding affinities as well as corresponding heterocyclic fluorophores. The technology consists of a suite of fluorescent RNA-fluorophore complexes within the “Mango” that have been optimized for live-cell imaging of RNA molecules without altering biological function, in a manner analogous to the way that fluorescently labeled proteins are used to study specific protein functions within cells. As such, this technology can be used as a powerful tool for live-cell study of RNA function and activity for research and diagnostic purposes. The prospective exclusive patent license will include terms for the sharing of royalty income with NHLBI from commercial sublicenses of the patent rights and may be granted unless within fifteen (15) days from the date of this published notice the NHLBI receives written evidence and argument that establishes that the grant of the license would not be consistent with the requirements of 35 U.S.C. 209 and 37 CFR part 404.

Complete applications for a license that are timely filed in response to this notice will be treated as objections to the grant of the contemplated exclusive patent license. In response to this Notice, the public may file comments or objections. Comments and objections, other than those in the form of a license application, will not be treated confidentially, and may be made publicly available.

License applications submitted in response to this Notice will be presumed to contain business confidential information and any release of information from these license applications will be made only as required and upon a request under the Freedom of Information Act, 5 U.S.C. § 552.

Licensing information and copies of patent applications may be obtained by emailing Brian W. Bailey, PhD, bbailey@mail.nih.gov, the indicated licensing contact at the National Heart, Lung, and Blood, Office of Technology Transfer and Development Office of Technology Transfer, 31 Center Drive Room 4A29, MSC2479, Bethesda, MD 20892-2479; telephone: 301-402-5579. A signed Confidential Disclosure Agreement may be required to receive any unpublished information.

Licensing Contact: Brian W. Bailey, PhD; 301-594-4094; bbailey@mail.nih.gov.

Bruce D. Goldstein,
Director, Office of Technology Transfer and Development,
National Heart, Lung, and Blood Institute,
National Institutes of Health.